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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/385,671 | 08/27/1999 | CHARLES ERIC HUNTER | WT-1 | 9516 |

23377 7590 04/09/2007
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| EXAMINER |
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STRANGE, AARON N

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| ART UNIT | PAPER NUMBER |
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2153

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/385,671 | Applicant(s) HUNTER, CHARLES ERIC | |
| | Examiner Aaron Strange | Art Unit 2153 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. As an initial matter, the Examiner would like to express willingness to conduct an interview to discuss potential amendments prior to filing a response in this application. The Examiner feels that an interview could help facilitate a mutual understanding of the respective positions of Applicant and the Office, and potentially expedite prosecution of the present application. If Applicant feels that an interview would expedite prosecution, he/she is encouraged to contact the Examiner to schedule one.

2. Applicant's arguments filed 1/25/07 have been fully considered but they are not persuasive.

3. With regard to Applicant's assertion that the specification of the present application, particularly page 28, line 17 to page 29, line 6 provide support for the present claims under 35 USC 112, first paragraph, the Examiner respectfully disagrees.

Claim 68 currently recites "transmitting ... a plurality of video programs to ... a plurality of consumer locations *for automatic buffering* at the consumer locations without consumer selection or using individual consumer preference information" (emphasis added). This is substantially the same scope as the claims discussed in the Office action of 7/25/2006. As discussed in the Office action of 7/25/06, it is clear from several locations in the specification that consumers must preselect programs for recording (at least Page 1, Lines 8-11 Page 4, Lines 12-20; Page 19, Lines 13-18; Page 27, Lines 14-22).

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Applicant's arguments emphasize that the movies are "transmitted" without consumer selection or using individual consumer preference information (Page 8 of Remarks). As discussed in the Office action of 7/25/06, such a limitation would find support *if taken alone*. However, the claims state that the movies are "transmitted" "for automatic buffering" without consumer selection or using individual consumer preference information. As discussed above, it is clear that no automatic buffering occurs unless preselected by the user.

If Applicant intends for only the transmitting to occur without selection/preference usage, the Examiner recommends amending the claim to recite "transmitting, without consumer selection or using individual consumer preference information, a plurality of video programs to a plurality of consumer locations; automatically buffering a portion of the transmitted video programs in response to preselections made by users at said consumer locations", or similar language which clearly shows that the transmission step occurs without election/preference usage, and the programs are only buffered if preselected.

However, in the interest of expedited prosecution, the Examiner would like to note that incorporating the recommended language, while likely to overcome the 35 USC 112, first paragraph rejection, is unlikely to differentiate the claims from the previously cited references to Russo and Waters.

Specification

4. The amendment filed 9/19/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: automatic buffering of video at the consumer locations without consumer selection or using individual consumer preference information. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 68-90 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. The rejection of claims 68-90 under 35 U.S.C. 112, first paragraph, presented in the Office action of 2/9/2006 is **MAINTAINED**. The rationale behind the rejection was

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discussed in the Office action of 2/9/2006, and further explained in the Office action of 7/25/2006 (¶3) and ¶2 above.

The amendments made to claims 68, 80 and 85 do not overcome the 35 U.S.C. 112, first paragraph rejection. The prior discussions relating to the automatic storage of the movies applies equally to the automatic buffering of the movies, since the buffering only occurs immediately prior to storage (at least Page 28, Lines 17-22 of present application).


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS 3/30/2007



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